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CHAMPAGNE, DONALD	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 18

Application Number: 09/295,864
Filing Date: April 21, 1999
Appellant(s): FELDSTEIN ET AL.

Craig S. Fisher, Esq.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 29 October 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct. . There is a minor error at the fourth line from the end: "dynamically computer" should be -- dynamically compute --.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The examiner agrees with appellant's statement that claims 1-32 should stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,901,287	Bull et al.	05-1999
4,845,658	Gifford	07-1989
5,432,904	Wong	07-1995
5,931,878	Chapin, Jr.	08-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 7 August 2003 (Paper No. 15).

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with amendment D on 29 April 2003 have been fully considered but they are not persuasive. Many of the arguments have been addressed in the last Office action. The new arguments and the amendment have been addressed by revision of para. 5-6 below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

   (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-9, 12-22, 25-28, 30 and 32 are rejected under 35 USC 103(a) as obvious over Bull et al. in view of Gifford.

4. Bull et al. teaches (independent claims 1, 12 and 25) a computer-implemented method for displaying personalized information on a client system, a display device for rendering said information thereon, and a computer-readable medium containing the method, the method comprising: collecting data associated with a user ((col. 3 lines 36-37); processing the data to create unique user profiles (col. 31 lines 37-42); tracking at least a portion of the data and providing the user with a variety of search options (col. 3 line 63 to col. 4 line 6), which reads on performing estimation calculations to generate results and updated personal information using the client; and automatically communicating the results and the personalized and updated information to the user via the client (col. 3 lines 55-57). Bull et al. also teaches

(independent claim 32) categorizing at least a portion of the query (the user's activity) as trackable data (col. 3 lines 34-35).

5. Bull et al. does not teach adjusting the results dynamically on the client. Gifford teaches adjusting the results dynamically on the client (col. 10 lines 35-48). Gifford teaches that this permits the user's most frequent requests to be answered from the local terminal (client, col. 10 lines 39-41). Because this would be understood by one of ordinary skill in the art to eliminate delays in communicating with the server, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Gifford to those of Bull et al.

6. Neither Bull et al. nor Gifford teach adjusting the results dynamically on the client by a user's interaction with the results. However, Gifford does teach that a user can compile, and therefore update, a list of queries (col. 10 lines 41-43). It is obvious for a user to update the list of queries in response to finding deficiencies in the results, which reads on interacting with the results. Hence, in view Gifford, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to adjust the results dynamically on the client by a user's interaction with the results.

7. Bull et al. also teaches: (claims 2 and 13) an interactive computer environment (col. 4 line 15); (claims 3, 4, 16, 17 and 26) with communication over the WWW in HTML (col. 3 lines 58 and 52); (claims 5, 6, 14, 15, 18, 19 and 27) providing interactive graphical control interface options (col. 3 line 61 and col. 4 line 15); (claims 7 and 20) user characteristics including the user profiles (col. 4 lines 20-23); (claims 8 and 21) transmission of results by personalized e-mail (col. 4 line 12); (claims 9, 22 and 28) allowing real-time interaction with the information (col. 4 line 15); and (claim 30) using the classification profile to demographically and statistically perform target marketing (col. 14 lines 19-25).

8. Claims 10, 11, 23, 24 and 29 are rejected under 35 USC 103(a) as obvious over the references cited above and further in view of Wong.

9. Neither Bull et al. nor Gifford teaches calculating projected automobile repair costs. Wong teaches calculating projected automobile costs. Because the combination would be very helpful to user's negotiating damage settlements with their auto insurance companies, it would have been obvious to one of ordinary skill in the art, at

the time of the invention, to combine the teachings of Wong with those of Bull et al. and Gifford.

10. None of the references teach computing projected prices of automobiles. Official Notice is taken (MPEP § 2144.03) that this limitation is common, and has obvious value to automobile buyers. The NADA blue book has been available on disc or CD for many years, and the Consumers Union has also offered an on-line auto price service for many years. It would therefore have been obvious to one of ordinary skill in the art, at the time of the invention, to add this limitation.

11. Claim 31 is rejected under 35 USC 103(a) as obvious over the references cited in para. 2 above and further in view of Chapin, Jr.

12. Neither Bull et al. nor Gifford teaches using automobile mileage to estimate maintenance schedules. Chapin, Jr. teaches (col. 2 lines 49-52) using automobile mileage to estimate maintenance schedules. Because Bull et al. and Gifford teach features that would enhance the simple system of Chapin, Jr., it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Bull et al. and Gifford to those of Chapin, Jr. These enhanced features include a global reach for data over the Internet while still maintaining the advantages of local processing.

(11) Response to Argument

There is just one issue: Whether rejection para. 5 and 6 above are correct. Appellant states the issue as follows in the first para. on brief p. 5 of 9:

> "It is the Appellants' position that the combination of Bull et al. and Gifford lacks at least one material feature of the claimed invention. Namely, the combination of Bull et al. and Gifford fails to disclose, either explicitly or implicitly, the Appellants' claimed adjusting of results dynamically by a user's interaction with the results." (Emphasis is in the original.)

Appellant argues that the two references in combination "lacks at least one material feature" of the claimed invention, and "fails to disclose" the claimed feature of the invention. That is acknowledged in rejection para. 6. It is, of course, also a specious criticism. A rejection under 35 USC 103(a) does not require that the references teach or

disclose every feature of the claimed invention. It is perfectly sufficient that some features of the invention be suggested by the prior art (*In re Royka*, quoted at MPEP § 2143.03).

The final rejection has two deficiencies. First, the rejection divided the issue into two parts, represented respectively by para. 5 and 6. In fact, the examiner now finds that para. 5 is not complete; the material in para. 6 is necessary to complete the argument, as will be explained below.

Second, the rejection (para. 6) argues that a feature of the invention is not taught by either of the references, but would be obvious. The examiner has since discovered that that supposed missing feature is in fact taught by the secondary reference, Gifford, at col. 6, lines 21-26. The rejection will be explained below both in the way it was originally presented, and revised using this new material from the secondary reference. It is helpful to first continue the review of appellant's argument.

In the second and third para. on brief p. 5 of 9, appellant discusses what the claimed invention does. In the last para., appellant presents a condensation of rejection para. 5 and 6.

The material that continues on brief p. 6 of 9, up to and including the first full para. on p. 7 of 9, is a discussion of the secondary reference, Gifford. Its relevance to the issue is not clear to the examiner. The examiner interprets this material as a challenge to the combination of the two references, so it is helpful to consider the two references broadly. Each of the references is summarized nicely by its abstract.

The general problem to be solved is to find and provide personalized information. The references represent two philosophical extremes in solving this problem. At each extreme, there is a tradeoff between completeness in access to information and speed of access. Bull et al. teaches ultimate access to all available databases, but that inherently entails server delays in providing the information to the user. Gifford teaches local storage of some information, which eliminates server delays for at least some searches, but of course does not provide all possible databases locally. Gifford

illustrates the general problem nicely with a Venn diagram as Fig. 2, which is discussed at col. 6 lines 9 to 29.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine these two references on any of several grounds, for they each contain useful and different individual features intended to solve various aspects of the same problem. To argue otherwise is to argue that the completeness-speed tradeoff was not well known at the time of the invention.

The essence of appellant's argument is at the beginning of the second full para. on brief p. 7 of 9:

> "the user is merely interacting with queries, not results ... results are not being adjusted. In fact, results to a query have not yet been obtained when a user creates a filter list. This is because the filter list is needed to process the query." (Emphasis is in the original).

This is true, but only for the initial query. As explained in rejection para. 6, it is obvious for queries to be revised because an initial query does not always produce the expected results. Revising and resubmitting a query because the results of the initial query were inadequate does read on the claimed adjusting of results by a user's interaction with the results.[1] Appellant acknowledges (end of the second para. on brief p. 3 of 9) that user interaction includes viewing of the results.

Gifford does in fact teach revising and resubmitting a query at col. 6 lines 22-26. In retrospect, the examiner should have written para. 5 and 6 of the final rejection as the following single paragraph:

5. Bull et al. does not teach adjusting the results dynamically on the client by a user's interaction with the results. Gifford teaches, as follows, adjusting the results dynamically on the client by a user's interaction with the results. First, Gifford teaches reviewing results and submitting a revised query based on that review (col. 6 lines 22-26), which reads on adjusting the results by a user's interaction with the results. Second, Gifford teaches (col. 10 lines 35-48) processing user requests

[1] "Dynamic" adjustment, another claimed feature, is taught at col. 10 lines 47-48 of Gifford.

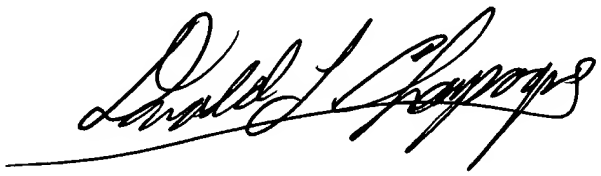
dynamically on the client. Gifford teaches that this permits the user's most frequent requests to be answered from the local terminal (client, col. 10 lines 39-41). Because this would eliminate delays in communicating with the server, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Gifford to those of Bull et al.

At the last para. on brief p. 7of 9, appellant argues that the combination of references does not teach or suggest being able to "quickly access and adjust information dynamically and in real time without server delays". First, the limitation "without server delays" is not claimed. However, this advantage is inherent to locating a database and enabling searches on the local terminal (client), and Gifford teaches that at col. 10, lines 39-41.

Appellant reviews the rejections of subordinate claims on brief p. 8 of 9, but does not introduce new argument therein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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1 January 2004

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